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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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51518 7590 06/16/2009 MAYER & WILLIAMS PC 251 NORTH AVE. WEST 2ND FLOOR WESTFIELD, NJ 07090				
EXAMINER				
NGUYEN, THUY-VI THI				
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3689				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/784,545

Applicant(s)

GEORGE ET AL.

Examiner

THUY VI NGUYEN

Art Unit

3689

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 7-24 and 27-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 7-24 and 27-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This is in response to the applicant's communication filed on 03/09/2009, wherein
Claims 1-36 are currently pending;
Claims 5-6, 25-26 have been cancelled;
Claims 1 and 21 have been amended;

As on 03/23/09, claim 1 is amended as follow:

1. (Currently Amended) A method for processing at least one digital image to provide a photofinishing product to a user, comprising:
receiving at least one digital image located on a physical medium provided by the user;
responsive to a request from the user ~~request~~, offering to the user at least one operator- definable package of photofinishing products;
receiving an input specifying at least one package selected by the user;
transferring the digital image onto a second physical medium; and
manually providing a photofinishing product to the user in accordance with the specified package,
wherein the package of photofinishing products includes ~~a the second physical medium onto which the digital image is transferred.~~

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
4. Claims 1-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over PARULSKI (US Patent No. 6,915,273) in view of URABE ET AL (US 7,363,235).

Regarding **claim 1**, PARULSKI discloses a method for processing at least one digital image to provide a photofinishing product to a user, comprising:

a) receiving at least one digital image located on a physical medium provided by the user

{see figures 2 (steps 116-118), col. 8, lines 14-24 *disclose customer uploads a digital image from a physical medium such as a particular CD or stored in digital camera or card reader* and col. 11, lines 62-67; col. 12, lines 1-5; figures 1A-B 6 and 7, step

(117)... *user uploads digital images from removable memory card (330) to the fulfillment center (40) through network channel (36)}*

b) responsive to a request from the user, offering to the user at least one operator-definable package of photofinishing products

{see col. 6, lines 31-45; and figure 2, steps (106 and 110) and figures 3-4, ... *a menu of photo products for customization such as printed sizes, matte style, frame are available to customer to select...*};

c) receiving an input specifying at least one package selected by the user [... *user selects a menu of customizable features such as printed sizes*; col. 6, lines 39-45 and figure 2, steps (108, 112)]; and

d) uploading on a server and producing the digital image onto a second physical medium;

{see figures 2, 5 (steps 116, 118), col.8, lines 47-60 which discloses "...*the digital images are printed to produce to hardcopy prints..*" which is interpreted as a second physical medium.

e) manually providing a photofinishing product to the user in accordance with the specified package

{see col. 9, lines 6-11; figure 2, steps (118-124), *photo product is delivered to the customer*}},

Note: for convenience, letters (a)-(e) are added to the beginning of each step.

PARULSKI discloses the claim invention as indicated above. For example **PARULSKI** discloses the customer uploads a digital image from a physical medium

such as a particular CD or stored in digital camera to the server, and the digital images are printed to produce the hard copy prints, including the framed prints which is considered as package of photofinishing products as shown on {figures 2 and 5, at least col. 8, lines 14-60}. However, PARULSKI does not explicitly disclose transferring the digital image to a second physical medium e.g. a CD-ROM or (step d) and this second physical medium is included in the package of photofinishing products (part of step e).

URABE ET AL cites the teaching of transferring the digital image in to a physical medium/a record medium e.g. a CD ROM, a memory card and deliver the record medium to the customer side based on the customer's request {see col. 10, lines 15-18; col. 15, lines 15, 25; col. 16, lines 30-53 e.g. *"image of each category are recorded/(transferred) on a record medium such as CD-R are sold to the customer"* and *"a delivery package of the record medium"*. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the method for providing a photo product and delivering the photo product/package to the designated recipients/customers of PARULSKI to include delivering digital image in a physical medium as a package to the customer based on the customer request as taught by URABE ET AL in order to provide the customer/user a chance to copy, view the images electronically , or send the images my email to user's family and friends instead of viewing the photo product from the hard copy as if desired by the customer or user.

Regarding **claim 2**, PARULSKI discloses the package of photofinishing products includes a photographic print of the digital image provided in predetermined quantities and at least one predetermined size [figures 3-4].

Regarding **claim 3**, PARULSKI discloses the package of photofinishing products includes a photographic print of the digital image provided in predetermined quantities for each of a plurality of predetermined sizes [figures 3-4].

Regarding **claim 4**, PARULSKI discloses the package of photofinishing products further includes a price for said package [figure 2, step (106)].

Regarding **claim 7**, it would have been obvious to use a disk if desired for further digital processing or permanent memory. PARULSKI/URABE ET AL discloses said second physical medium is a CD-ROM {see URABE ET AL col. 15, lines 15-25; col. 16, lines 45-54}.

Regarding **claim 8**, Paulski discloses receiving at least one digital image includes the step of receiving a plurality of digital images located on the physical medium [...user uploads digital images from removable memory card (330) to the network services provider; col. 11, lines 62-67; col. 12, lines 1-5; figures 6 and 7, step (117)]

and further comprising the step of receiving from the user a second input identifying at least one of the digital images to be embodied in the photofinishing product [...user can also select preferred colors, messages or images for the custom album cover; col. 8, lines 40-43].

Regarding **claim 9**, PARULSKI discloses the step of displaying the digital images prior to the step of receiving the second input from the user [...after the digital images are uploaded, the user can also select preferred colors, messages or images for the custom album cover; col. 8, lines 25-28; col. 40-43 and figure 2, step (118)].

Regarding **claim 10**, PARULSKI discloses the step of receiving an input from the user specifying at least one enhancement to the digital image [...customized graphics, text or image templates (col. 2, line 62); colors and logo; (col. 8, lines 40-43)].

Regarding **claim 11**, PARULSKI discloses said enhancement is selected from the group consisting of brightness, contrast and retouching [...customized graphics, text or image templates (col. 2, line 62); colors; (col. 8, lines 40-43)].

Regarding **claim 12**, PARULSKI discloses the step of receiving from the operator an input defining the predetermined quantities and the predetermined size of the package [...receiving the product information such as album the page size; col. 7, lines 57-66 and figure 5].

Regarding **claim 13**, PARULSKI discloses said input is received at least in part via a touch screen display [...touchscreen display 84; col. 4, lines 53-54; and figure 1A].

Regarding **claim 14**, PARULSKI discloses said input is received at least in part via a keyboard [...keyboard 16; figure 1A].

Regarding **claim 15**, PARULSKI discloses said input is received over a communications network [...network service provider 30; col.3, lines 56-59 and figure 1A-B].

Regarding **claim 16**, PARULSKI discloses said inputs are received at least in part via a touch screen display [...touchscreen display 84; col. 4, lines 53-54; and figure 1A].

Regarding **claim 17**, PARULSKI discloses said inputs are received at least in part via a keyboard [...keyboard 16; figure 1A].

Regarding **claim 18**, PARULSKI discloses inputs are received over a communications network [...network service provider 30; col.3, lines 56-59 and figure 1A-B].

Regarding **claim 19**, PARULSKI discloses wherein the offering step is performed via a graphical user interface displayed on a monitor [...a menu of customizable features of photo product is displayed on monitor 14 or touchscreen display 84 for customer select; col. 6, lines 39-39-43 and figure 1A].

Regarding **claim 20**, PARULSKI discloses the step of scanning at least one photographic image to produce said at least one digital image [...scanner 94; col. 4, lines 57-59 and figure 1A].

Regarding **claim 21**, PARULSKI discloses a digital photofinishing system, comprising:

a) a digital image reader for receiving a physical medium on which at least one digital image is located

[...card reader 96; col. lines 65-67 and figure 1A];

b) a digital image processor for producing an output image from the digital image located on the physical medium

[...CPU mother board 82; col. 4, lines 45-49 and figure 1A];

c) an image output device for embodying the output image in an output medium [...color hardcopy printer 54; col. 5, lines 46-48 and figure 1B];

d) a monitor for displaying the output image and offering to a user at least one operator-definable package of photofinishing products

[...touchscreen display 84; col. 4, lines 53-54 and figure 1A];

e) a controller operatively associated with the digital image reader, the digital image processor, the image output device and the monitor

[...fulfillment center (40) communicates with home computer system (10) or retails kiosk 80 to perform the steps of selecting, configuring, purchasing and shipping a photo product (60); see col. 3, lines 56-61; col. 5, lines 7-10; and figures 1A-1B];

f) an operator interface operatively associated with the controller for selectively defining at least one package of photofinishing products to be offered to the user [...touchscreen display (84) in retails kiosk (80) or home computers system (10) for user to selecting the type of photo product to purchase; figures 1A-B]

Note: for convenience, letters (a)-(f) are added to the beginning of each step.

PARULSKI discloses the claim invention as indicated above. For example **PARULSKI** discloses the customer uploads a digital image from a physical medium such as a particular CD or stored in digital camera to the server, and the digital images are printed to produce the hard copy prints, including the framed prints which is considered as package of photofinishing products as shown on {figures 2 and 5, at least col. 8, lines 14-60}. However, **PARULSKI** does not explicitly discloses transferring the digital image to a second physical medium e.g. a CD-ROM or (step e) and this second physical medium is included in the package of photofinishing products (part of step f).

URABE ET AL cites the teaching of transferring the digital image in to a physical medium/a record medium e.g. a CD ROM, a memory card and deliver the record medium to the customer side based on the customer's request {see col. 10, lines 15-18;

col. 15, lines 15, 25; col. 16, lines 30-53 e.g. *"image of each category are recorded/(transferred) on a record medium such as CD-R are sold to the customer" and "a delivery package of the record medium"*. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the method for providing a photo product and delivering the photo product/package to the designated recipients/customers of PARULSKI to include delivering digital image in a physical medium as a package to the customer based on the customer request as taught by URABE ET AL in order to provide the customer/user a chance to copy, view the images electronically , or send the images my email to user's family and friends instead of viewing the photo product from the hard copy as if desired by the customer or user.

Regarding **claim 22**, PARULSKI discloses the package of photofinishing products includes a photographic print of the digital image provided in predetermined quantities and at least one predetermined size [figures 3-4].

Regarding **claim 23**, PARULSKI discloses the package of photofinishing products includes a photographic print of the digital image provided in predetermined quantities for each of a plurality of predetermined sizes [figures 3-4].

Regarding **claim 24**, PARULSKI discloses the package of photofinishing products further includes a price for said package [figure 2, step (106)].

Regarding **claim 27**, PARULSKI discloses said second physical medium is a CD-ROM [...input digital image from a CD-Rom disc; see col. 4, lines 61-63].

Regarding **claim 28**, PARULSKI discloses said image output device comprises a printer [...color hardcopy printer 54; col. 5, lines 46-48 and figure 1B].

Regarding **claim 29**, PARULSKI discloses a user interface for receiving an input from the user specifying at least one enhancement to the digital image [...a menu of customizable features of photo product is displayed on monitor 14 or touchscreen display 84 for customer select; col. 6, lines 39-39-43 and figure 1A].

Regarding **claim 30**, PARULSKI discloses said enhancement is selected from the group consisting of brightness, contrast and retouching [...customized graphics, text or image templates (col. 2, line 62); colors; (col. 8, lines 40-43)].

Regarding **claim 31**, PARULSKI discloses said operator interface further serves as a user interface for receiving an input from the user specifying at least one enhancement to the digital image [...customized graphics, text or image templates (col. 2, line 62); colors and logo; (col. 8, lines 40-43)].

Regarding **claim 32**, PARULSKI discloses said operator interface comprises a touch screen display [...touchscreen display 84; col. 4, lines 53-54; and figure 1A].

Regarding **claim 33**, PARULSKI discloses said operator interface comprises a keyboard [...keyboard 16; figure 1A].

Regarding **claim 34**, PARULSKI discloses said user interface and said operator interface comprise a common touch screen display [...touchscreen display 84; col. 4, lines 53-54; and figure 1A].

Regarding **claim 35**, PARULSKI discloses said user interface and said operator interface comprise a common keyboard [...keyboard 16; figure 1A].

Regarding **claim 36**, PARULSKI discloses a scanner for scanning a photographic image to produce a digital image to be processed by the digital image processor [...scanner 94; col. 4, lines 57-59 and figure 1A].

Response to Arguments

5. Applicant's arguments on 03/23/09 with respect to claims 1-33 have been considered but are moot in view of the new ground(s) of rejection based on the new amended independent claims 1 and 21.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thuy-Vi Nguyen whose telephone number is 571-270-1614. The examiner can normally be reached on Monday through Thursday from 8:30 A.M to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on 571-272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/T. N./
Examiner, Art Unit 3689

/Tan Dean D. Nguyen/
Primary Examiner, Art Unit 3689